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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hubert Jacques Milon

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EXAMINER

KRAUSE, ANDREW E

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

01/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/566,285	Applicant(s) MILON ET AL.	
	Examiner ANDREW KRAUSE	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 3 is objected to because of the following informalities: "mg" in line 2 should be changed to "g". Appropriate correction is required. (see page 6, lines 29-33 of the specification).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1, 18 and 19 recite the limitation "high-caffeinated". The term "high-caffeinated" is a relative term which renders the claim indefinite. The term "high-caffeinated" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1794

6. Claims 1, 18, and 19 recite the limitation "conventional caffeine-containing coffee solids". It is unclear what types of coffee solids are considered conventional.

7. Claim 3 is rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 3 recites the limitation "acceptable" taste. It is unclear what taste is considered to be acceptable.

9. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 14 recites the limitation "the multiple sachets" in line 2. There is insufficient antecedent basis for this limitation in the claim, as it depends on claim 1, and not claim 13, wherein the multiple sachets are recited.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1794

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1,2,5,7,8,15-20** are rejected under 35 U.S.C. 103(b) as being anticipated by Les (GB 2,285,578A) in light of “Dr. Duke’s Phytochemical and Ethnobotanical Databases-‘Paullinia cupana’” (NPL Reference 1), and ‘Frequently Asked Questions About Coffee’ (NPL Reference 2).

13. **Regarding claims 1, 2, and 18-20**, Les discloses a caffeine delivery product, wherein the product comprises a coffee beverage to which Paullinia Cupana (Guarana) is added,(p. 2 lines 1-16) and also that the coffee can be in the form of filter bags (p.5, lines 1-2), which constitute a single serving sachet made of a rupturable material. Les further discloses producing the caffeinated product by mixing 5 mL of caffeinated coffee with 500 mg of Paullinia Cupana (Example 4, p. 9). In light of NPL Reference 1, which shows that Paullinia Cupana contains caffeine in an amount between 9100-76,000 ppm (9.1-76 mg/g), Les discloses a product containing conventional caffeine containing coffee solids and an additional 4.55-38 mg of caffeine from the Paullinia Cupana. Les discloses producing a coffee drink by mixing this powder with 200 mL of water that is indistinguishable in taste compared to regular coffee. NPL Reference 2 shows that a 7 oz (207 mL) cup of brewed coffee contains 80-135 mg of caffeine (Table on page 4). Therefore the beverage produced will contain between 84.55 and 173

Art Unit: 1794

mg of caffeine, derived from the soluble coffee beverage powder providing a liquid beverage upon reconstitution with water, the soluble beverage comprising conventional coffee solids and additional caffeine containing solids from a different natural source.

14. **Regarding claim 5**, Les further discloses that the additional caffeine containing solids can be obtained from the seeds of Guarana, or extracts thereof (p. 2, lines 8-12).

15. **Regarding claims 7 and 8**, Les further discloses the beverage comprising a vitamin premix (Examples 2 and 5).

16. **Regarding claims 15 and 16**, the beverage is prepared by the addition of 200 mL of water to the powder (example 4).

17. **Regarding claim 17**, Les discloses the product of claim 1, and the product having the same composition will result in the same effects when used as intended.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
20. Considering objective evidence present in the application indicating obviousness or nonobviousness. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. **Claim 13 is** rejected under 35 U.S.C. 103(a) as being unpatentable over Les (GB 2,285,578A) in light of "Dr. Duke's Phytochemical and Ethnobotanical Databases-'Paullinia cupana'" (NPL Reference 1), and 'Frequently Asked Questions About Coffee' (NPL Reference 2).

Art Unit: 1794

22. **Regarding claim 13**, the beverage is packaged into sachets that each contain a serving with a known amount of caffeine. Creating multiple sachets containing portions of this serving represents only a change in size of the product. It would have been obvious to one having ordinary skill in the art at the time of the invention to change the size of the sachet to adjust the caffeine serving size, since a change in size is generally recognized as being within the level of ordinary skill in the art. *Gardner vs. TEC Systems, Inc.*, 725 F. 2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 US. 830, 225 USPQ 232 (1984).

23. **Claims 3,4,9,10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Les (GB 2,285,578A) in light of “Dr. Duke’s Phytochemical and Ethnobotanical Databases-‘Paullinia cupana’” (NPL Reference 1), and ‘Frequently Asked Questions About Coffee’ (NPL Reference 2) as applied to claim 1 above, in view of Stipp (US 5,554,400).

24. Les discloses the product of claim 1, but fails to disclose that there is 5 to 30 g of powder incorporated into the sachet. Les discloses adding a 5 mL scoop of ground coffee (Examples 1, 4), but fails to disclose the mass of the scoop.

25. However, Stipp discloses producing a 6 oz(177 mL) coffee drink using 5 grams of roast and ground coffee to obtain a flavorful beverage(examples 6 and 2), and comprising a total of 13.2 g of powder, or 13.7 with the addition of Paullinia cupana to improve the stimulant effects as disclosed in Les. It would

Art Unit: 1794

have been obvious to one having ordinary skill in the art to combine the product of Les with the use of 5 g of coffee to produce a 6 oz cup as disclosed by Stipp, because a 5g quantity of coffee is capable of yielding a flavorful coffee beverage (column 15, lines 20-23).

26. **Regarding claim 4**, the product of Les and Stipp would contain 13.7 g of powder, 5 g being conventional coffee solids, and 0.5 g being the additional Paullinia cupana. This composition would therefore contain 36.5% coffee solids, and 3.65% additional caffeine containing solids.

27. **Regarding claim 9**, Les discloses the product of claim 1, but fails to disclose it further comprising one of the claimed additional components.

28. However, Stipp discloses beverage sachets comprising a sachet filled with an infusable material, such as coffee, and additionally, sweetener and creamer (a whitener) (column 2, lines 33-43, column 7 lines 58-65), as well as flavoring (example 6).

29. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the coffee product disclosed by Les, with the addition of sweetener and whitener to the packet as disclosed by Stipp, because having each product available in the same packet eliminates the need of the drinker to add sugar and creamer to the beverage separately (column 1, lines 30-36).

Art Unit: 1794

30. **Regarding claim 10**, Stipp further discloses that the coffee and additional components are blended together (column 15, lines 18-20). This step is considered to put the powdered ingredients in a homogeneously mixed condition. It would have been obvious to one having ordinary skill in the art at the time of the invention to blend the powder to obtain a homogeneously mixed condition to ensure an even infusion of the packet contents into the produced beverage.

31. **Claims 6,11,12 and 21 are** rejected under 35 U.S.C. 103(a) as being unpatentable over Les (GB 2,285,578A) in light of “Dr. Duke’s Phytochemical and Ethnobotanical Databases-‘Paullinia cupana’” (NPL Reference 1), and ‘Frequently Asked Questions About Coffee’ (NPL Reference 2) in view of Stipp (US #5,554,400) and Tsai (US #4,946,701) .

32. **Regarding claims 6,11, and 21**, Les discloses the product of claim 1, but fails to disclose the product containing the additional components. However, Stipp discloses a product further comprising a sweetener and whitener, (see rejection to claims 3 and 9). A product as disclosed by Les and Stipp will contain 13.7 g of powder, 5 g being conventional coffee solids, and 0.5 g being the additional caffeine containing component and 8 g being a 40%/56% whitener/sweetener blend. This composition would therefore contain 36.5% coffee solids, and 3.65% additional caffeine containing solids, as well as 23.4%

Art Unit: 1794

whitener and 32.7% sweetener. Les and Stipp fail to disclose the exact amounts of coffee and sweetener as claimed; however it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the amounts of coffee solids and sweetener to achieve the desired balance of sweet and bitter flavors for the intended purpose, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

33. Les and Stipp fail to disclose that the additional caffeine containing solids are derived from decaffeinated coffee solids, decaffeinated tea extracts or mixtures thereof and also (regarding claim 6) that there are flavanols present in a ratio of flavanols to caffeine of 1:0.02 to 1:1. However, Tsai discloses adding extracts of green tea to beverage mixes (column 3, lines 26-31), including those containing coffee (column 2, lines 30-34). A green tea extract that is used contains 95.7% catechins and 4.3% caffeine (examples 2 and 3), and is thus considered to be decaffeinated, though still containing caffeine in order to meet the limitation 'additional caffeine containing solids including decaffeinated tea extracts'.

34. It would have been obvious to one having ordinary skill in the art at the time of the invention modify the product of Les and Stipp with the addition of a decaffeinated tea extract as disclosed by Tsai, because adding tea extracts adds

Art Unit: 1794

flavanols to the beverage, which have soothing and healing benefits, such as lower blood pressure (column 1, lines 15-20).

35. Tsai further discloses that the tea extract should be added to the beverage mix in an amount capable of giving a ratio of flavanols to caffeine of 30:1 to 1:1 (column 3, lines 55-59). Therefore it would have been obvious to one having ordinary skill in the art to adjust the amount of tea extract added in relation to the other caffeine containing solids, the whitener and the sweetener in order to obtain the optimal amount of caffeine to obtain the optimal stimulant properties, and the optimal amount of flavanols to obtain the desired amount of soothing properties for the intended purpose, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

36. **Further regarding claim 21**, Les discloses the addition of vitamins (Examples 2 and 5), while Stipp discloses the addition of a flavoring components (coffee aromas in light of [0039] of the US PGPUB of the instant application) (column 5, lines 26-35, example 6, rejection to claims 3 and 9). Les, Stipp, and Tsai thus disclose a product containing coffee solids, decaffeinated tea extracts, coffee whitener, sweetener, guarana extracts, a coffee aroma, a flavor (Stipp discloses adding multiple flavors (column 5, line 36), so one can be considered a coffee aroma and another a flavor, and a flavanol. It would have been obvious to one

Art Unit: 1794

having ordinary skill in the art at the time of the invention to adjust the quantity of each to achieve the desired taste and physiological characteristics provided by the beverage for the intended purpose, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

37. **Regarding claim 12**, Lee, Stipp, and Tsai disclose the claimed invention except for separating the caffeine containing solid components from the remaining components. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the components separately, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

38. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Les (GB 2,285,578A) in light of “Dr. Duke’s Phytochemical and Ethnobotanical Databases-‘Paullinia cupana’” (NPL Reference 1), and ‘Frequently Asked Questions About Coffee’ (NPL Reference 2) as applied to claim 1, in view of Hopkins (US #2,027,342).

39. Les discloses the product of claim 1, but fails to disclose that multiple sachets are packaged in a larger container. However, Hopkins discloses packaging a plurality of individual servings of packaged coffee into a container

Art Unit: 1794

(p. 2, left column, lines 3-8). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the product of Les with the use of a large package containing multiple units allowing the use of the beverage sequentially over time as disclosed by Hopkins, because it allows the unused packages to remain sealed during the time that other packages are being used (p.2, left column, lines 15-19). Although the packets of Hopkins are sealed in a different method, packaging in this manner is equally beneficial for the product of Les.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KRAUSE whose telephone number is (571)270-7094. The examiner can normally be reached on 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ANDREW KRAUSE/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794